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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

STAIKOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 03/03/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/714,318

Applicant(s)

SWAAB, MARY

Examiner

Stefan Staicovici

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-33 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed November 29, 2002 (Paper No. 8) has been entered. Claims 1, 7-8, 11, 14, 19, 23 and 25-26 have been amended. No claims have been canceled. New claims 30-33 have been added.

Claims 1-33 are pending in the instant application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 7, 14, 19 and 26, the newly added limitation of pigments in "shapeless amorphous form" does not appear to have support in the original disclosure. Although the original disclosure appears to have support for pigments in a powder form (see page 8, lines 7-8 and Figure 1), the original does not have support for the broader limitation of pigments in "shapeless amorphous form" because said pigments may found as a liquid, a slurry, chunks, paste, etc.

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In claim 19, the limitation of heating *only* (emphasis added) the base, pouring the pigments into the heated base to form a mixture and then pouring the mixture into the mold does not appear to have support in the original disclosure. The original disclosure appears to have support for heating a mixture of pigments and at least one base prior to pouring said mixture in a mold.

Claims 8-13, 15-18, 20-25 and 27-33 are rejected as dependent claims.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 32-33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 32 and 33, the relationship between the “pre-mixture” and the “mixture” obtained by “pre-mixing” and respectively, “mixing” is unclear. Further clarification is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 7-18, 26-28 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Collins *et al.* (US Patent No. 5,780,018).

Regarding claims 7, 14 and 26, Collins *et al.* ('018) teach the claimed process of manufacturing customized (personal specifications of a person) lipstick (lip coloring) including, selecting a particular color shade by a customer, providing a molding kit having a mold, a plurality of pigments provided as color pellets (pigments) or a colored semi-solid paste (shapeless amorphous form) and a plurality of doses of oil blend (bases), measuring an amount of color pellets/semi-solid paste, mixing said color pellets/semi-solid paste with said oil blend, heating said mixture, pouring said mixture in a mold and cooling said mixture in said mold to form said customized lipstick. Further regarding claim 14, it should be noted that recitation of the intended use of the claimed process of making a customized lip-coloring product must result in a structural difference between the claimed process and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure, as taught by Collins *et al.* ('018) is capable of performing the intended use, as claimed, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art and as such whether the process is performed at a retail establishment or at home does not appear to provide patentability to the method upon which patentability must be determined.

In regard to claim 8, Collins *et al.* ('018) teach heating of said plurality of color pellets (pigments) and said plurality of doses of oil blend (bases) prior to mixing (see col. 6, lines 27-35). It is submitted that measuring of an amount of color pellets/semi-solid paste has occurred prior to mixing.

Specifically regarding claim 9, Collins *et al.* ('018) teach using a plurality of different color pellets (pigments) in order to obtain a customized color shade (see col. 6, lines 12-22).

Regarding claims 10 and 18 Collins *et al.* ('018) teach a semi-solid paste as a color pellet. Since, Collins *et al.* ('018) specifically teach mixing of said color pellets with an oil blend, it is submitted that a semi-solid paste with an oil blend is mixed on a blending sheet since a paste is a semi-solid substance that is spread during mixing.

In regard to claim 11, Collins *et al.* ('018) teach the use of a metered dose system (see col. 3, line 57).

Specifically regarding claims 15-16, Collins *et al.* ('018) teach heating using a microwave oven (see col. 6, lines 27-35).

Regarding claims 12-13, 17 and 27-28, Collins *et al.* ('018) teach removing the molded lipstick from the mold and affixing a casing prior to giving said molded lipstick to the customer. Since the customer receives the molded lipstick it is submitted that said customer waits at the retail establishment while said customized lipstick is being molded.

In regard to claim 31, Collins *et al.* ('018) teach a plurality of oil blends that may be used (see col. 3, lines 13-30).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins *et al.* ('018) in view of Beal, Jr. (US Patent No. 4,611,611).

Collins *et al.* ('018) teach the basic claimed process of manufacturing customized (personal specifications of a person) lipstick (lip coloring) including, selecting a particular color shade by a customer, providing a molding kit having a mold, a plurality of pigments provided as color pellets (pigments) or a colored semi-solid paste and a plurality of doses of oil blend (bases), mixing said color pellets with said oil blend, heating said mixture, pouring said mixture in a mold and cooling said mixture in said mold to form said customized lipstick.

Regarding claim 1, Collins *et al.* ('018) do not teach applying the mixture to the customer for evaluation. Beal, Jr. ('611) teaches an applicator to test lipstick coloring at a retail establishment (see col. 2, line 66 through col. 3, line 4). Further, it should be noted that Beal, Jr. ('611) specifically teaches the desirability of testing a lipstick color on a person's lips prior to purchasing said lipstick (see col. 1, lines 17-21). Therefore, it would have been obvious for one of ordinary skill in the art to have applied the mixture to the customer for evaluation as taught by Beal, Jr. ('611) in the process of Collins *et al.* ('018) because, Beal, Jr. ('611) specifically

teaches the desirability of testing a lipstick color on a person's lips prior to purchasing said lipstick and also because, both references have applicability in the lipstick art.

In regard to claims 2 and 3, Collins *et al.* ('018) teach heating of said plurality of color pellets (pigments) and said plurality of doses of oil blend (bases) prior to mixing (see col. 6, lines 27-35).

Specifically regarding claims 4 and 6, Collins *et al.* ('018) teach removing the molded lipstick from the mold and affixing a casing prior to giving said molded lipstick to the customer. Since the customer receives the molded lipstick it is submitted that said customer waits at the retail establishment while said customized lipstick is being molded.

Regarding claim 5, Collins *et al.* ('018) teach a semi-solid paste as a color pellet. Since, Collins *et al.* ('018) specifically teach mixing of said color pellets/semi-solid paste with an oil blend, it is submitted that a semi-solid paste with an oil blend is mixed on a blending sheet since a paste is a semi-solid substance that is spread during mixing.

10. Claims 19-20, 22-25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins *et al.* ('018) in view of Beal, Jr. (US Patent No. 4,611,611) and in further view of Lombardi *et al.* (US Patent No. 6,177,093 B1).

Collins *et al.* ('018) in view of Beal, Jr. ('611) teaches the basic claimed process as described above.

Regarding claims 19, 25 and 29-30, Collins *et al.* ('018) in view of Beal, Jr. ('611) do not teach repeating the selecting, measuring and mixing steps in order to achieve the desired shade. Lombardi *et al.* ('093) teach a process for customizing a lipstick including, providing a customer



request (selecting), measuring, mixing and heating a plurality of colored pellet material to obtain a customized color according to said request, transferring said heated material to a mold, cooling said mold and disassembling said mold to release said customized lipstick (see col. 2, line 67 through col. 3, line 14). Further, since Lombardi *et al.* ('093) teach modifying the final color based upon customer input *during the manufacturing process* (emphasis added) (see col. 3, lines 23-27) and since Lombardi *et al.* ('093) teach a customized lipstick, it is submitted that Lombardi *et al.* ('093) teach repeating the steps of selecting, measuring and mixing as described above. Therefore, it would have been obvious for one of ordinary skill in the art to have modified the final color based upon customer input during the manufacturing process (repeating the steps of selecting, measuring and mixing) as taught by Lombardi *et al.* ('093) in the process of Collins *et al.* ('018) in view of Beal, Jr. ('611) because, Lombardi *et al.* ('093) specifically teach modifying the color of a customized lipstick based upon customer input and also because, both references teach similar end-products and solve similar problems of providing a customized color sale to a customer at the point-of-sale. Further, it should be noted that Beal, Jr. ('611) specifically teaches the desirability of testing a lipstick color on a person's lips prior to purchasing said lipstick (see col. 1, lines 17-21). Further regarding claim 19, it should be noted that the open-language "comprising" allows for heating of a base and pigment mixture and not only a base.

In regard to claim 20, Collins *et al.* ('018) teach a semi-solid paste as a color pellet. Since, Collins *et al.* ('018) specifically teach mixing of said color pellets/semi-solid paste with an

oil blend, it is submitted that a semi-solid paste with an oil blend is mixed on a blending sheet since a paste is a semi-solid substance that is spread during mixing.

Specifically regarding claim 22, Collins *et al.* ('018) teach adding moisturizers, an anti-oxidant and a perfume to the oil blend (base) and to the color pellet (see col. 3, lines 7-28).

Regarding claim 23, Collins *et al.* ('018) teach heating of said plurality of color pellets (pigments) and said plurality of doses of oil blend (bases) prior to mixing (see col. 6, lines 27-35). It is submitted that measuring of an amount of color pellets/semi-solid paste has occurred prior to mixing.

In regard to claim 24, Collins *et al.* ('018) teach removing the molded lipstick from the mold and affixing a casing prior to giving said molded lipstick to the customer.

Specifically regarding claim 25, Collins *et al.* ('018) teach heating of said plurality of color pellets (pigments) and said plurality of doses of oil blend (bases) prior to mixing (see col. 6, lines 27-35).

11. Claims 30 and 32-33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins *et al.* ('018) in view of Lombardi *et al.* (US Patent No. 6,177,093 B1) and in further view of Beal, Jr. (US Patent No. 4,611,611).

Collins *et al.* ('018) teaches the basic claimed process as described above.

Regarding claims 30 and 32-33, Collins *et al.* ('018) in view of Beal, Jr. ('611) do not teach adjusting the color of the mixture. Lombardi *et al.* ('093) teach a process for customizing a lipstick including, providing a customer request (selecting), measuring, mixing and heating a plurality of colored pellet material to obtain a customized color according to said request,

transferring said heated material to a mold, cooling said mold and disassembling said mold to release said customized lipstick (see col. 2, line 67 through col. 3, line 14). Further, since Lombardi *et al.* ('093) teach modifying the final color based upon customer input *during the manufacturing process* (emphasis added) (see col. 3, lines 23-27) and since Lombardi *et al.* ('093) teach a customized lipstick, it is submitted that Lombardi *et al.* ('093) teach repeating the steps of selecting, measuring and mixing as described above. Further, it should be noted that Lombardi *et al.* ('093) teach "premixing" the components and then in view of repeating the steps of selecting, measuring and mixing as described above, Lombardi *et al.* ('093) teach "mixing" the components. Beal, Jr. ('611) teaches an applicator to test lipstick coloring at a retail establishment (see col. 2, line 66 through col. 3, line 4). Further, it should be noted that Beal, Jr. ('611) specifically teaches the desirability of testing a lipstick color on a person's lips prior to purchasing said lipstick (see col. 1, lines 17-21). Therefore, in view of the desirability to test the color of the lipstick as taught by Beal, Jr. ('611) it would have been obvious for one of ordinary skill in the art to have modified the final color based upon customer input during the manufacturing process as taught by Lombardi *et al.* ('093) in the process of Collins *et al.* ('018) because, Lombardi *et al.* ('093) specifically teach modifying the color of a customized lipstick based upon customer input and also because, all references teach similar end products and have applicability in the lipstick art.

*Allowable Subject Matter*

12. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

13. Applicant's remarks filed November 29, 2002 (Paper No. 8) have been considered.

Applicant argues that Collins *et al.* ('018) does not teach a plurality of pigments in an "amorphous shapeless form." However, as shown above the newly added limitation of pigments in "shapeless amorphous form" does not appear to have support in the original disclosure. Although the original disclosure appears to have support for pigments in a powder form (see page 8, lines 7-8 and Figure 1), the original does not have support for the broader limitation of pigments in "shapeless amorphous form" because said pigments may found as a liquid, a slurry, chunks, paste, etc. Further, it should be noted that Collins *et al.* ('018) teaches a plurality of pigments provided as either color pellets (pigments) or a colored semi-solid paste. It is submitted that a semi-solid paste is a "shapeless amorphous form".

Applicant argues that Lombardi *et al.* ('093) do not teach "adjusting the base pigment mixture after it has actually been applied to the lips of a person for evaluation" (see page 6 of the amendment filed November 29, 2002). However, Applicant's argument is moot in view of the new ground(s) of rejection.

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*Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino, can be reached at (703) 308-3853. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD



Primary Examiner

2/24/02

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February 24, 2003